

### REMARKS

Claims 1-6, 8-14 and 16-24 are pending in this application. Reexamination and reconsideration are respectfully requested.

The Examiner rejected Claims 1-4, 6, 8-14 and 16-24 under 35 U.S.C. § 103(a) as being unpatentable over Hsien (US 6,441,804) in view of Klein (US 6,259,367). This rejection is respectfully traversed.

This rejection was traversed in Applicant's prior amendment and remarks, which arguments are incorporated herein by reference for brevity. The Examiner summarized these arguments and responded as follows:

Applicant argues where Hsien and Klein do not employ a shared antenna since a capacitively couple system such as Klein could simply not employ an RF antenna such as Hsien. Examiner, respectfully disagrees. With reference to MPEP 2141, *KSR International Co. v. Teleflex, Inc.*, the elements of the wireless mouse, RFID tag and reader in combination did no more than they would in separate, sequential operation.

It is respectfully submitted the Examiner misapplied the test set out in MPEP 2141. The portion relied on is clearly the following quote from *KSR* of *Anderson's-Black Rock, Inc. v. Pavement Salvage Co* (quoted at MPEP 2141 page 2100-115) :

"In *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, . . . [t]he two [pre-existing elements] in combination did no more than they would in separate, sequential operation." *Id.* at \_\_\_, 82 USPQ2d at 1395..."

This rationale for establishing prima facie obviousness is expanded in greater detail at MPEP 2143 (page 2100-129):

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the

combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969)... If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art." (Emphasis added.)

This requirement of no change in function was indeed met in *Anderson's-Black Rock, Inc. v. Pavement Salvage Co* (as discussed immediately following the above at MPEP 2141 page 2100-129) :

The claimed invention in *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 163 USPQ 673 (1969) was a paving machine which combined several well-known elements onto a single chassis. ... The Court found that the operation of the heater was in no way dependent on the operation of the other equipment.... (Emphasis added.)

The above requirement of no change in function is not met here. As stressed by Applicant as noted by the Examiner in the above quote, the two prior art systems cannot be combined into the claimed structure with no change in their functions due to the functional incompatibility of the capacitive system of Klein and the conventional RF antenna of Hsien. The operation of one system is dependent on the other in order to share an antenna. The Examiner did not rebut this in any way but instead made a conclusory statement incorrectly based on the rationale of *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*

According to MPEP § 2142 :

[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that 'rejections on obviousness cannot be

sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.' *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). (Emphasis added.)

It is respectfully submitted the Examiner has clearly not met this test. Instead the Examiner has merely provided a conclusory rationale based on an incorrect application of the test in MPEP 2141. Accordingly, it is respectfully submitted the Examiner has failed to clearly articulate a prima facie case of obviousness and the rejection is fully traversed.

The Examiner rejected Claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Hsien in view of Klein as applied to Claim 1, and further in view of Lieu, et al. (US 6,445,379). This rejection is respectfully traversed.

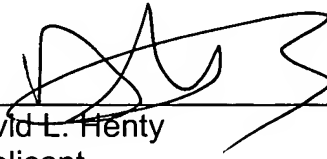
It is respectfully submitted the base combination of Hsien in view of Klein as applied to Claim 1 is not supported by the appropriate standards of obviousness as discussed above. Accordingly, this rejection equally cannot be supported and this rejection is fully traversed for the same reasons.

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In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and a Notice of Allowance is respectfully requested. It is requested that the Examiner telephone the undersigned Applicant if it appears that any impediment remains to allowance of the application.

Respectfully submitted,

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